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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/673,451

09/30/2003

Chikashi Okamoto

2004

7590

10/04/2004

MATTINGLY, STANGER & MALUR, P.C.

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Alexandria, VA 22314

EXAMINER

LEE, DIANE I

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,451

Applicant(s)

OKAMOTO ET AL.

Examiner

D. I. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/857,271.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 07 July 2004. Claim 1 has been canceled; claims 9-14 have been newly added. Currently, claims 9-14 are pending in this application.

Specification

2. The abstract of the disclosure remains objected to because of the following(s):
 - (a) Line 3: "or in" should be deleted; and
 - (b) Line 5: delete extra spaces. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.**

The omitted elements are:

- (a) said sheet having an element obtainable by said scanning unit
(i.e., claim 9, line 20, reads "*said scanning unit acquiring information obtained from said sheet*" but in claim 9, lines 4-6 read, "*said sheet including an electronic circuit chip which stores a unique number*").

Therefore, applicant omitted to provide an essential element of the sheet in the claim for the scanning unit to obtain.

Appropriate correction and clarification is required

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5. Claims 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claim 9, lines 4-6 read, "*said sheet including an electronic circuit chip which stores a unique number and is difficult to rewrite the same*". It is unclear what characteristic of electronic circuit chip or unique number makes it difficult to rewrite the same. Is it the structure of the electronic circuit chip or type of the unique number? Applicant has failed to defined structurally or functionally the difficulty of rewriting the same. Thus, applicant has failed to particularly point out the claim subject matter.

(b) Claim 9, line 16 reads, "*said control unit taking out from said memory device ..*". Previously claim recites "*said memory device storing unique information ...*" in line 7-8. The phrase "taking out from the memory device" is unclear. For examining purpose, the phrase has been translated as -- obtaining said stored unique information from the memory device--.

(c) Claim 9, lines 20-21 read, "*said scanning unit acquiring information obtained from the sheet*". It is unclear what element or information from the sheet is acquired by the scanning unit. Applicant failed to recite the element or information of the sheet for the scanning device to acquire (see the discussion above).

Therefore, claim 9 and claims depend therefrom (claims 10-14) are vague and indefinite.

Appropriate correction and clarification is required.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. **Claims 9-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,659,353 [referred as Patent'353].** Although the conflicting claims are not identical, they are not patentably distinct from each other because Patent'353 discloses all the claimed limitation, for example:

Patent'353 teaches a sheet management system and a method of checking the sheet as to forgery thereof, wherein said sheet being provided with an electronic circuit chip from or in which information can be read out or written and having visible information (see claims 1 and 8). The electronic circuit chip of the sheet includes a network connection such as a data communicating means (i.e., a means for transmitting signals generated to be unique to the sheet) (see claim 8). The system include a means for identification, which inherently includes the claimed control unit, scanning the sheet, which inherently includes the claimed scanning unit, and a determining discriminatively authenticity of the sheet, which also inherently includes the claimed discriminating unit (see claims 1, 4, 6-10).

In view of above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teachings of claims 1-10 of Patent'353 as a general teachings for a system of checking sheets to forgery as claimed by the present application. The instant claim obviously encompass the claimed invention of Patent'353 and broader in scope.

Allowable Subject Matter

8. Claims 9-14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph (see the discussion above) and upon timely filing of a Terminal Disclaimer to overcome the Double Patenting rejection (see the discussion above), set forth in this Office action.

9. The following is an examiner's statement of reasons for allowance:

Hoshino discloses a method of checking sheet (i.e., a document) as to forgery thereof, said sheet being provided with memory or data storage (an optical code such as a magnetic strip or a bar code) from in which information can be read out or written and the sheet further includes an additional information on the sheet (i.e., a predetermined visible indication data such as figures, characters, symbols, etc.). The system encrypts the visible information of the sheet and stores the encrypted visible information in the optical code, and determines discriminatively authenticity of the sheet on the basis of the visible information of the sheet and the information stored in the optical code.

Hiroya discloses a sheet having an electronic circuit chip for storing the information.

One of ordinary skill in the art would not have been motivated to modify the teachings of Hoshino and Hiroya in order to provide a system that detecting forgery of a sheet, which includes a forgery detecting device having a control unit, a scanning unit, and a discriminating unit, wherein the forgery detecting device and memory device which are connected via a network, wherein the control unit of the forgery detecting device read the stored data from the electronic circuit chip provided in the sheet and obtains the unique information, which correlating said unique number, from the memory device via said network, wherein the scanning unit acquires scanned information from the sheet, such that the authenticity of the sheet is determined by the discriminating unit by comparing the obtained information from the control unit and the scanning, as set forth in the claims.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is (571) 272-2399. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. I. Lee
Primary Examiner
Art Unit 2876

D. L.